



UNITED STATES PATENT AND TRADEMARK OFFICE

9/1
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,378	12/12/2001	James Sheung Lau	CA920000074US1 (7161-208U)	2828
46320	7590	01/18/2006	EXAMINER	
CHRISTOPHER & WEISBERG, PA			SIMITOSKI, MICHAEL J	
200 E. LAS OLAS BLVD			ART UNIT	PAPER NUMBER
SUITE 2040				2134
FT LAUDERDALE, FL 33301				

DATE MAILED: 01/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/015,378	LAU, JAMES SHEUNG
	Examiner	Art Unit
	Michael J. Simitoski	2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 November 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) 25-28 and 36-39 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 and 29-35 is/are rejected.
- 7) Claim(s) 23 and 24 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 11 March 2002 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____

DETAILED ACTION

1. The response of 11/18/2005 was received and considered.
2. Claims 1-39 are pending.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-24 & 29-35, drawn to instruction codes for sending registration information to a server and controlling use of content in response to a key received, classified in class 726, subclass 28.
 - II. Claims 25-28 & 36-39, drawn to deactivation of instruction codes in response to receipt of registration information from a user computer, classified in class 726, subclass 33.
4. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as decrypting content upon registration, not requiring deactivation of instruction codes. See MPEP § 806.05(d).
5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. During a telephone conversation with Scott Paul (954-736-8306) on 1/4/2006 a provisional election was made without traverse to prosecute the invention of group I, claims 1-24 & 29-35. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 25-28 & 36-39 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Arguments

7. Applicant's arguments with respect to claims 1-24 & 29-35 have been considered but are moot in view of the new ground(s) of rejection. As described in the interview summary of 11/2/2005, the Ginter reference uses instruction codes of an operating environment, rather than the content to be controlled, to control access to content. The amended claims are now treated in such a way that the code for establishing the connection and controlling usage of the content is embedded with the content and is self-executing, as opposed to Ginter's embedded codes which direct a secure operating environment code to perform the functions.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification discloses the act of determining the memory usage of functional descriptive material, but does not describe the

steps required to do so and does not describe how to integrate this into the invention in such a way that one of ordinary skill could make and/or use the invention.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-15, 19-20 & 29-35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,070,171 to Snyder et al. (**Snyder**).

Regarding claims 1, 3, 6, 10-11, 15, 19-20, 29-30 & 32-35, Snyder discloses embedding in computer readable content/software (col. 2, lines 25-28 & col. 12, lines 21-25), instruction codes operable to direct a processor circuit to automatically establish a connection to a server (col. 12, lines 28-30), when said content/software is in use by said processor circuit (col. 12, lines 28-30), to transmit registration information/token to said server (col. 12, lines 28-30) and operable to control further use of said content/software by said processor circuit (Fig. 3a, #48) in response to a key/new token and permission received from said server (col. 12, lines 36-37 & Fig. 3a, #48).

Regarding claims 2, 7 & 9, Snyder discloses a portable memory medium/CD-ROM (col. 11, lines 34-42 & col. 12, lines 12-15).

Regarding claims 4-5 & 31, Snyder discloses a self-executing applet/tracker client (col. 12, lines 12-15).

Regarding claim 8, Snyder discloses transmitting said computer readable content and said embedded instruction codes on a communications network/email (col. 12, lines 56-58).

Regarding claims 12-14, Snyder discloses producing a measure of use of said content/current token (col. 7, lines 20-21).

12. Claims 1-11, 16-20 & 29-35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication 2004/0225900 to **Colvin**. Colvin teaches embedding, in computer readable content, instruction codes (¶29) operable to direct a processor circuit to automatically establish a connection to a server (¶29 & ¶32), when said content is in use by said processor circuit, to transmit registration information to said server (¶32), and operable to control further use of said content by said processor circuit in response to a key/authorization code (¶29 & ¶32-33), wherein the instruction codes/software include self-executing (installation) application code.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder**, as applied to claim 12 above, in further view of U.S. Patent Application Publication 2003/0078853 to Peinado et al. (**Peinado**).

Regarding claim 16, Snyder lacks establishing a connection to said server when said measure of use exceeds a threshold value. However, Peinado teaches by including a license with a description of constraints to be met before content is rendered (¶18), a user is restricted to a limited number of uses of content (¶128 & ¶136). Peinado further discloses that the user can obtain additional access to the content by contacting the server to obtain a valid license (¶137 & ¶140). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to contact the server when a measure exceeds a threshold. One of ordinary skill in the art would have been motivated to perform such a modification to limit the number of uses of the content, as taught by Peinado (¶18, 128, 133-137 & 140).

Regarding claim 17, Snyder discloses an internet protocol connection (col. 4, lines 40-43).

15. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder** and **Peinado**, as applied to claim 17 above, in further view of U.S. Patent Application Publication 2002/0046181 to Story, Jr. et al. (**Story**). Snyder, as modified above, discloses a browse session with a uniform resource locator/web site pointing to a user registration page (¶140-¶141), but lacks explicitly the page permitting a user to enter registration information. However, Story teaches that it is known to use a web page to authenticate a user before supplying the user with a

license (¶39). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to use the web page supplied by the server to permit the user to enter registration information. One of ordinary skill in the art would have been motivated to perform such a modification to authenticate the user before authorizing the creation of a license, as taught by Story (¶39).

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder**, as applied to claim 20 above, in further view of U.S. Patent 5,946,677 to **Bullen**. Snyder, as modified above, lacks deleting files produced by functional descriptive content in said computer readable content. However, Bullen teaches that it is well known for application programs to generate temporary files that are generally unneeded and which must later be deleted to free up additional storage capacity (col. 2, lines 12-15). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to delete files produced by functional descriptive content/tracker client and software in said computer readable content/software. One of ordinary skill in the art would have been motivated to perform such a modification to free up additional storage capacity, as taught by Bullen (col. 2, lines 12-15).

17. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Snyder** and **Bullen**, as applied to claim 21 above, in further view of U.S. Patent 6,784,925 to Tomat et al. (**Tomat**). Snyder, as modified above, lacks warning a user of said processor circuit that files are about to be deleted. However, Tomat teaches that when temporary disk space runs low, it is

beneficial to warn a user that files need to be deleted (col. 23, lines 11-16). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Snyder to warn the user when files are about to be deleted. One of ordinary skill in the art would have been motivated to perform such a modification to allow the user to choose to modify the temporary storage space, as taught by Tomat (col. 23, lines 11-16).

Allowable Subject Matter

18. Claims 23-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Attention is specifically drawn to the following:

- a. The '954 patent teaches a self-launching application for creating a virtual volume containing an application to be tested or sampled, where if the predefined number of uses is exceeded, the volume is unmounted (files are deleted).
- b. The '256 patent teaches the steps required to modify an original file to create a "controlled executable" which controls access to the original file by embedding the control code into the original executable.
- c. The '288 patent teaches requiring a key at a partial installation of a program which requires the key to complete the installation.

Art Unit: 2134

- d. The '194 patent teaches automatically performing a roll-back (deletion of files) of an installation if the installation does not complete.
- e. The '469 patent teaches automatically uninstalling an application (deleting files) when it is not functioning correctly.
- f. The '002 patent teaches wrapping a control program around an original program to control the original program's access.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. – 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS

January 10, 2006



Gilberto Barron Jr.
GILBERTO BARRÓN JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100